

**UTILITY PATENT**

Attorney Docket No. MGM-0194

Response to Office Action Mailed: September 14, 2005

**REMARKS**

***Election/Restriction – 35 USC § 121***

Election of Group III without traverse and examination of claims 1- 2, 7-9, and 11-12 is accepted.

Amended claims 1, 2 and 8 are presented in this application for reconsideration and further examination. Original claims 7, 9, 11-12 which are dependent on either amended claim 1 or amended 2 are presented for reconsideration and further examination. Entry of this amendment is respectfully requested.

***Specification***

The Examiner objected to the specification under 37 CFR 1.71 for not disclosing the operation of the bundle breaker 7.

Applicants at page 1 lines 18 – 20 of the specification disclosed: "One bundle breaker which can be used with the present invention is the Martin bundle breaker disclosed in U.S. Serial No. 10/229,891 filed August 28, 2002."

Applicants intended but failed to state in precise words, that Martin bundle breaker disclosed in U.S. Serial No. 10/229,891 filed August 28 2002 was to be incorporated by reference, in its entirety, into the present application. Applicants have corrected this oversight by calling for the amendment of the specification at page 1 after the paragraph at line 20 which ends with the words "August 28, 2002". to add the following paragraph: Martin et. al. Serial No. 10/229,891 was granted patent No. 6,655,566 on December 2, 2003. Martin et. al. patent 6,655,536 is hereby incorporated by reference, in its entirety, into the present application."

Applicant requests that the Examiner accept the amendment requesting incorporation by reference under Manual of Patent Examining Procedure Section 608.01(p) I. Incorporation by Reference, paragraph A. Review of Applications which are to Issue as Patents, and paragraph 1. second paragraph which states: "If an application as filed incorporates essential material by reference to a U.S. patent or a pending and commonly owned U.S application, applicant may be required prior to examination to furnish the Office with a copy of the reference material together with an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the copy consists of the same material incorporated by reference in the referencing application. However, if a copy of a

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printed U.S. patent is furnished, no affidavit or declaration is required. Applicant wishes to state that U.S. patent 6,665,566 and the present application are commonly owned by the Martin Family Trust, Oakland, CA (US) and Daniel J. Talken is a joint inventor of both U.S. patent 6,665,566 and the present application. Applicants listed Martin et. al. Serial No. 10/229,891 filed 8-28-02, Bundle Breaker Improvement as "other Prior Art" in their Information Disclosure Statement mailed 9-15-03 to the United States Patent and Trademark Office. Examiner Alie considered the reference.

For the convenience of the Examiner, Applicants have included a paper copy of U.S. 6,655,566 granted Dec. 2, 2003 for Bundle Breaker Improvement. The undersigned has pointed out specific drawings and paragraphs of the specification below and would be most willing in addition point out the relevant parts of the patent, to answer any further questions the Examiner may have.

It is believed obvious to anyone skilled in the art that to store the present storable transfer conveyor 5 inside bundle breaker 7 a downstream end 47 merely need be placed on the upstream end of the belt of powered downstream conveyor 4', the conveyor belt 4' activated and storable transfer conveyor 5 can be pulled into the bundle breaker 7 and onto powered downstream conveyor 4". The upstream end of storable transfer conveyor 5 would of course be supported on upstream lift mechanism 48 and wheels 9 while the storage operation is taking place. It is also believed obvious that the bundle breaking operation, as shown in Fig. 14 of U.S. 6,655,566 tilting the downstream portion on hydraulic cylinders 102 and 115 about pivot point 103, should not be activated when the storable transfer conveyor 5 of the present application is being pulled into the control modified bundle breaker 7 of the present application.

To answer the Examiner's specific questions in paragraph 3, it may be seen from the operation of the bundle breaker in U.S. 6,655,566 that the bundle breaker 7 of the present application does not break the bundles when the storable transfer conveyor 5 is positioned above the downstream belt conveyors 4' and 4". The bundle breaker 7 only breaks the bundles when the storable transfer conveyor 5 of the present application is in the position shown in Fig. 4 of the present application. As to how the bundles are broken in the bundle breaker 7, please refer to Fig. 14 of U.S. Patent 6,655,566 and the specification at column 14, line 20-23.

The Examiner specifically asked: "Is the bundle manually loaded onto on the downstream belt conveyors 4" and 4", prior to being broken by the bundle breaker 7?" The short answer is, No. This question, is fully answered by referring to Figure 3 of the present application. In Figure 3 (prior art), a mobile roll out transfer

take away conveyor (prior art) is shown parked and inoperative at location 65. Bundles 18 are moving from stacker 17 to a floor conveyor 20. When bundles need to be broken by a bundle breaker 1 as shown in U.S. 6,655,566 the prior art mobile roll out transfer take away conveyor 64 is physically pushed by 2 or more men to a location between the upstream conveyor 3 and the bundle breaker 7'. This location is precisely where , as shown in Figure 2, storable transfer conveyor 5 of the present invention is located. This location is shown on Figure 2 as floor area 6. In summary, the bundles were not placed on conveyor belt 67 of the bundle breaker 1 described in U.S. 6,655,566 by hand, but were instead carried from the upstream conveyor 3 by the powered rollers on mobile roll out transfer take away conveyor 64 (Fig 4 of the present application) to the downstream conveyor of bundle breaker 1 shown in U.S. 6,655,566.

#### ***Claim Rejections 35 USC § 112***

The examiner correctly quotes 35 USC §112.

Examiner Alie rejected claims 7 – 9 and 11-12 under 35 U.S. 112 , first paragraph, as containing subject matter which is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, regarding claim 7, Examiner Alie was of the opinion that the disclosure failed to disclose a bundle breaker machine, which included the downstream conveyor, breaks the bundle when the storable transfer conveyor is pulled onto the downstream conveyor.

- a. Applicant's believe that by the incorporation by reference of the disclosure of the bundle breaker in U.S. Patent 6,655,566 into the specification of the present application applicants have met the requirements of 35 USC §112 and that the disclosure does enable one skilled in the art to which it pertains to make and/or use the invention.
- b. To answer Examiner Alie's questions specifically, bundles are not broken when the storable transfer conveyor 5 is pulled onto the downstream conveyor 4. The storable transfer conveyor 5 when stored, prevents any bundles from being broken. When the storable transfer conveyor 5 is stored in the bundle breaker 7, the bundles proceed straight ahead to conveyor 20 as shown in Fig. 2 of the present application.
- c. Examiner Alie was not clear on how the bundles were broken. This question may be answered by referring to U.S. patent 6,655,566 and the description set forth above.

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d. Examiner Alie was not clear how the bundles were loaded onto the bundle breaker patent 6,655,566. This question was answered in the explanation set forth above. Again, the bundles were not loaded into the bundle breaker by hand, but by a conveyor with powered rollers.

e. In conclusion, Applicants request that the disclosure of the bundle breaker machine be incorporated by reference into the present application and for the reasons set forth above, applicant requests that amended claims 7-9 and 11-12 be reconsidered in view of the above explanation and the rejection under 35 USC § 112 be removed.

The Examiner correctly states the requirements of the second paragraph of 35 U.S. 112 and is understood by Applicants.

The Examiner states that claims 2, 7 – 9 and 11-12 are rejected under 35 U.S.C 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Regarding Claim 2, the Examiner was not clear how the storable transfer conveyor 5 can be pulled directly onto the downstream conveyor 4 by the pulling means 4' of the transfer conveyor 5.

b. The Examiner is correct in stating that the pulling means 4', by itself, cannot pull the transfer conveyor 5 onto the downstream conveyor 4 and that the transfer conveyor should be placed on the pulling means 4' of the downstream conveyor 4 before it is pulled by powered pulling means 4' onto the downstream conveyor.

c. Applicants thank the Examiner for pointing out that claim 2 as originally written is inaccurate.

d. Applicants have amended claim 2 to call for the storable transfer conveyor 5 to be placed on top of a portion of the downstream conveyor 4. As shown in the drawings, particularly Fig. 4, a lift means 8 which includes hydraulic lift mechanism 12 and upstream lift mechanism 48 lifts the very heavy storable transfer conveyor 5. As shown in Fig. 8 when storable transfer conveyor 5 has reached an elevation where the bottom transfer conveyor 5 is at or slightly above the elevation of power conveyor 4', it is relatively easy for the operator to nudge the storable conveyor 5 onto a portion of downstream conveyor 4 or 4' because the weight rests on a pair of wheels mounted on wheel support 56 and on a pair of wheels 9.

e. Alternatively, wheels 9 could be powered to drive the storable conveyor onto downstream conveyor the first few inches.

f. Claim 2 has been amended to call for the powered pulling means 4 to pull the storable transfer conveyor onto a substantial portion of the downstream conveyor and into the stored second position.

g. Applicant's believe by incorporating by reference U.S. patent 6,655,566 into the present application, that it may now be understood by persons skilled in the art how to move storable transfer conveyor 5 into a stored or parked position in the bundle breaker and that claim 2 as amended now accurately describes the storing or parking operation.

### ***Claim Objections***

Applicants thank Examiner Alie for calling attention to the fact that "juxtaposition was incorrectly spelled. Correction has been made in claim 1 and in the specification at line 7 on page 24.

### ***Claim Rejections 35 USC § 102***

Examiner Alie correctly states 35 U.S. 102

Examiner Alie rejected claim 1 under 35 U.S.C. 102(b) as being anticipated by Nussbaum et al. (3,643,939). Applicants respectfully disagree. To clarify the distinction between Nussbaum and Applicant's system, applicant has amended the preamble of claim 1. Applicant has called for "An efficient factory production line transitional storable transfer conveyor system for selectively moving bundles.....".

a. As pointed out in Applicants lengthy background of the invention in the specification, and by providing Figure 3 which shows the prior art factory production line system in comparison with the factory production line system of the present invention in Figure 2, Applicants have shown how to efficiently transition a factory production line from delivering large unbroken bundles to either a discharge conveyor (see Fig. 3 prior art) or to a bundle breaker 7 as shown in Figure 2.

b. Nussbaum does not disclose, teach or even suggest a system for selectively transitioning the flow of bundles from one production line to another. Nussbaum simply transfers bundles from an upstream conveyor to a downstream shingling conveyor; and that is it.

c. In setting up a system for transitioning from one factory production line to another production line, applicants have disclosed a way to efficiently "park" the "storable transfer conveyor 5 so that when bundles are moved from the stacker 17 as shown in Fig. 3 to a discharge conveyor 20, operator 61 may quickly and safely move as shown by path 62 to position 61'. (Further reasons

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for moving storable transfer conveyor 5 are set forth in the specification on page 2, lines 30 – 33, and on page 3, lines 1 – 6). In contrast, Nussbaum does not teach or suggest how his machine could be used to permit an operator to pass from one side of his machine safely and quickly when his transfer conveyor 26 is moved from a vertical position as shown in dotted line to a horizontal position shown in solid line in Figure 3. Note in Nussbaum Figures 1 and 3, the amount of machinery an operator would have to step over to reach the other side of the machine, such as the endless belt 70 and its supporting structure as well as the power rollers 80 and their supporting structure. Even with transfer conveyor 26 pivoted to a horizontal position as shown in Fig. 3, a substantial portion of conveyor 26 is still obstructing the air space above the floor causing a substantial head injury problem, should an operator try and duck below the conveyor 26.

- d. Applicant's have further amended claim 1 to call for the storable transfer conveyor 5 to not only vacate the floor area 6 shown in Figure 2, but also to substantially vacate the air space above floor area 6 to permit free and unimpeded access and travel by the operator through the floor area 6 when the storable transfer conveyor 5 in its second stored inoperative position.
- e. As stated above, when Nussbaum moves his transfer conveyor, he neither substantially vacates the floor area or the air space above it to permit an operator to move from one side of his machine to the other.
- f. Finally, applicant sets forth in claim 1 that when storable transfer conveyor is selectively moved to a second stored position, it no longer takes up floor area because it is positioned in elevational juxtaposition with the downstream conveyor; viz. on top of the downstream conveyor or within the bundle breaker. This freeing up of valuable floor space is a major advantage. Before applicants invention, as shown in prior art Figure 3, mobile roll out transfer conveyor 64 was parked in another location on the crowded factory floor. As stated in the specification on page 3, lines 9 – 11, "As one production engineer recently stated, real estate on a busy factory floor is more expensive than real estate in downtown San Francisco". In contrast, Nussbaum does not free up any floor space when his transfer conveyor 26 is pivoted up from the floor.
- g. Applicant has extensively amended Claim 1 to distinguish Nussbaum. Applicant has added the word "selectively" to indicate that Applicants system is part of two production lines that selectively send bundles to a bundle breaker 7 for breaking the bundles or sends the unbroken bundles to a different downstream conveyor 20 (see Fig. 1 for further processing).

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h. Applicant has amended claim 1 to call for the storable transfer conveyor 5 to be selectively moveable to a second stored position "substantially vacating said floor and said air space there above'.... permitting free unimpeded access and travel by said operator through said floor area when said storable transfer conveyor is in said second stored inoperative position." As stated above, Nussbaum does not vacate the floor area or the space above.

**Comment**

The examiner listed 20 prior art patents which were considered pertinent and made of record but not relied upon. The undersigned has carefully reviewed each and every one of these patents and is of the belief that applicants amended claims are patentably distinguishable over each and one of the patents individually or in any proper combination.

**Conclusion**

Amended Claims 1, 2, and 8 as well as dependent claims 7,9, and 11-12 remain in the application and allowance is respectfully requested for the reasons set forth above.

Please direct any calls in connection with this application to the undersigned at (510) 832-4111.

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Attachments: Transmittal, Return Receipt Post Card, Paper copy of US  
6,655,566 Martin and Talken granted 12/2/2003 and Check  
No: 1212 for \$60.00.

Respectfully submitted,

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